

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB OCT. 29,99  
U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Warren Smith  
v.  
Big Guy, Inc.

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Cancellation No. 25,964

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Parker H. Bagley and Steven R. Gustavson of Baker & Botts,  
L.L.P. for Warren Smith.

Robert A. Jensen & Clark A. Puntigam of Jensen & Puntigam,  
P.S. for Big Guy, Inc.

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Before Hairston, Wendel and Bucher, Administrative  
Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

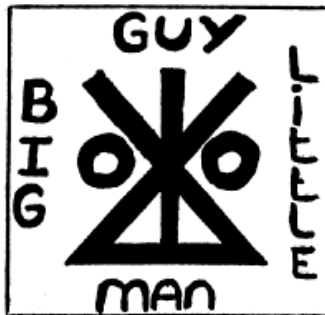
Warren Smith (petitioner) seeks cancellation of a  
registration owned by Big Guy, Inc. (respondent), a  
Washington State corporation.<sup>1</sup> Respondent owns a  
registration on the Supplemental Register for the mark,  
"BIG GUY" as applied to "men's wearing apparel; namely, T-

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<sup>1</sup> Big Guy, Inc. was substituted as the sole party defendant,  
in place of James A. Wold, after the filing of this cancellation  
petition, based upon the assignment of the subject registration,  
as recorded in the U.S. Patent and Trademark Office.

shirts, sweatshirts, sweat pants, shorts, shirts and outerwear," in International Class 25.<sup>2</sup>

As the ground for cancellation, petitioner alleges priority of use and likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d). In support of this allegation, petitioner alleges that he is the owner of a federal registration for the mark "BIG GUY / Little Man (and design)," in the hand-lettered form shown below, for "undergarments; namely, undershorts and shirts," also in International Class 25:<sup>3</sup>



Petitioner also claims to have used the term "BIG GUY" alone, in a trademark manner, on shirts and hats, since February 1, 1993 - long prior to registrant's asserted date of first use. Hence, petitioner alleges that respondent's

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<sup>2</sup> Registration No. 1,906,847 matured from an intent to use application given a filing date of March 2, 1992. Respondent allegedly first made use of the mark on December 10, 1993. The application was amended to an application on the Supplemental Register on January 6, 1995, which registration issued on July 18, 1995.

<sup>3</sup> Reg. No. 1,798,760, issued on October 12, 1993, claiming first use in commerce on February 1, 1993. This registration matured from an intent to use application that petitioner filed for the "BIG GUY/Little Man (and design)" mark on January 2, 1992. Section 8 affidavit filed on October 1, 1999.

mark, "BIG GUY," when applied to the goods identified in respondent's registration, so resembles petitioner's marks as to be likely to cause confusion, to cause mistake or to deceive.

Respondent, in its answer, denies that petitioner has any superior rights in the term "BIG GUY" alone, and contends that there is no likelihood of confusion between the two parties' marks as registered.

The record consists of the pleadings; the file of the involved registration; and, as petitioner's case-in-chief, petitioner's June 18, 1998 declaration with attached documents.<sup>4</sup> Respondent has submitted no evidence in this proceeding. Both parties have filed briefs, petitioner filed a reply brief, but no oral hearing was requested.

We turn our attention first to the question of which party has established priority of use. Section 7(c) of the Trademark Act, 15 U.S.C. §1057(c), confers constructive use on petitioner dating from the filing of his application for registration of his mark, contingent upon registration on the Principal Register of his mark shown above. See Jimlar Corp. v. Army and Air Force Exchange Service, 24 USPQ2d 1216, at fn.5 (TTAB 1992); and Zirco Corp. v. American Telephone and Telegraph Co., 21 USPQ2d 1542 (TTAB 1991). Hence, as the owner of Reg. No. 1,798,760, petitioner has

constructive use of its composite mark as of January 2, 1992. This is prior to any first use date respondent has even alleged anywhere in the current record.<sup>5</sup> Although petitioner also claims common law rights in the use of the term "BIG GUY" alone, dating back to February 1993, given our disposition of this case, we do not find it necessary to consider this allegation. Based upon the cited registration alone, priority belongs with petitioner.

This brings us to the issue of likelihood of confusion. In the course of rendering this decision, we have followed the guidance of In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 1362, 177 USPQ 563, 567-68 (CCPA 1973), which sets forth the factors that should be considered, if relevant, in determining likelihood of confusion.

Respondent agrees with petitioner that the parties' goods travel in the same channels of trade, that the clothing items at issue are impulse purchases, that there is no evidence of other similar marks being used by third

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<sup>4</sup> The parties agreed pursuant to 37 CFR §2.123(b) that the testimony of the witnesses could be submitted in affidavit form.

<sup>5</sup> Respondent's subsisting registration on the Supplemental Register is not entitled to any statutory presumptions, and is not evidence of anything except that the registration issued. See McCormick & Co. v. Summers, 354 F.2d 668, 148 USPQ 272 (CCPA 1966); In re Medical Disposables Co., 25 USPQ2d 1801 (TTAB 1992); Copperweld Corp. v. Arcair Co., 200 USPQ 470 (TTAB 1978); Andrea Radio Corp. v. Premium Import Co., 191 USPQ 232 (TTAB 1976); Aloe Creme Laboratories, Inc. v. Johnson Products Co., 183 USPQ 447 (TTAB 1974); Nabisco, Inc. v. George Weston Ltd., 179 USPQ 503

parties, that they have both marketed their goods for some number of years without any known instances of actual confusion, and that there is no market interface between these parties.<sup>6</sup> As a result, the above factors are either neutral or weigh in favor of petitioner. Although petitioner claims a degree of "fame" for his mark, we agree with respondent that the record falls far short of demonstrating that petitioner's mark is deserving of that designation.

We turn to the goods herein, which the parties agree are "closely related." In comparing the goods of the parties as listed in their respective identifications of goods, we conclude for purposes of our likelihood of confusion analysis that some items are nearly identical - both petitioner and respondent are selling t-shirts, or shirts in the nature of undergarments.

Finally, we turn our focus to the marks. While petitioner and respondent arrive at quite opposite conclusions, the parties seem to agree that the sole du Pont factor on which this case should turn is the similarities or dissimilarities of the two registered marks. We begin with the premise that "when marks would appear on virtually identical goods or services, the degree

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(TTAB 1973); and Aloe Creme Laboratories, Inc. v. Bonne Bell, Inc., 168 USPQ 246 (TTAB 1970).

<sup>6</sup> Respondent's Brief, pp. 3 - 5.

of similarity necessary to support a conclusion of likely confusion declines." Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Petitioner asserts that "BIG GUY" is the dominant element of its composite mark, while respondent claims that the design feature is the dominant element of petitioner's composite mark. Both parties recognize the well-established principle that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

Petitioner's mark consists of the words "BIG GUY / Little Man" positioned around all four sides of a prominent design feature. The design feature of this mark cannot be ignored. Nevertheless, as a general proposition, where a composite mark contains both wording and design elements, it is the wording that is usually the dominant portion thereof. This is true because the wording is the "brand name" to which potential consumers will resort in requesting the particular goods sought. See In re Appetito

Provisions Co., 3 USPQ2d 1553, 1554 (TTAB 1987); Kabushiki Kaisha Hattori Tokeiten v. Scuotto, 228 USPQ 461, 462 (TTAB 1985); and In re Morrison Industries, Inc., 178 USPQ 432, 433 (TTAB 1973). Thus, in this case, we find that "BIG GUY / Little Man" is the dominant portion of petitioner's mark.

Moreover, it is a well-established principle that likelihood of confusion should not be judged based upon a side-by-side comparison of the marks. Instead, we must take into account that over a period of time, people in the marketplace for goods such as these have an imperfect recall of marks. See Geigy Chem. Corp. v. Atlas Chem. Indus., Inc., 438 F.2d 1005, 1007, 169 USPQ 39, 40 (CCPA 1971) ["HYDRONOL" so resembles "HYGROTON" when applied to diuretics that confusion is likely].

As to the connotation of the designation "BIG GUY" in petitioner's mark, the positive message that petitioner promotes so aggressively imbues the term "big guy" with the connotation of a mature, male, role-model who gives and gets respect.<sup>7</sup> The mark is used on all sizes of clothing,<sup>8</sup> and the term as used by petitioner is in no way tied to the body size of the person wearing the apparel. In this regard, respondent does not argue that the designation "BIG GUY" is a weak mark because it, or others in the trade, use

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<sup>7</sup> Warren K. Smith Declaration, ¶¶ 1, 3, 7, 8 & 13; Attached Exhibits E through H.

<sup>8</sup> Warren K. Smith Declaration, ¶¶ 6, 12 & 13.

the words "big guy" as a designation for large-sized men's clothing. To the contrary, respondent and petitioner have agreed that third parties in the area of men's wearing apparel are not using this terminology, or at least not in the trademark sense shared by these two parties.

In a related vein, we note that respondent's mark is on the Supplemental Register because during *ex parte* examination, the Trademark Examining Attorney concluded that the specimens submitted to the Patent and Trademark Office to support the statement of use show the matter "BIG GUY" being used in an ornamental fashion. Accordingly, this case seems analogous to the fact pattern of *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994), where this Board found confusion between "ROAD KILL CATERING" and "ROAD KILL CLUB OF AMERICA and design" as applied to t-shirts:

The cited mark in the case before us presents a different situation from the Supplemental Register registrations which were considered in the cases cited by applicant and by Professor McCarthy. ... It appears that this mark was placed on the Supplemental Register not because it was descriptive, but because, ... the Examining Attorney was of the opinion that it would be perceived as ornamentation on the shirts, rather than as a trademark. ... [W]e see no basis for treating it as a descriptive mark in terms of the likelihood of confusion analysis.



*In re Smith and Mehaffey supra* at 1533.<sup>9</sup>

Accordingly, there is no reason, based on the instant record, to conclude that the term "BIG GUY" is a weak source identifier for these goods. As a result of the above analysis of the similarities of the marks, we find that this critical *du Pont* factor too favors petitioner.

Decision: The petition to cancel is granted and Registration Number 1,906,847 will be cancelled in due course.

P. T. Hairston

H. R. Wendel

D. E. Bucher  
Administrative Trademark  
Judges, Trademark Trial  
and Appeal Board

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<sup>9</sup> While finding a likelihood of confusion, the Board in *Smith and Mehaffey* also conceded, in a way arguably analogous to the facts of the instant case: "We agree ... that the design portion is a large and very noticeable element of the registered mark."